

## **Remarks**

This paper is responsive to the Final Office Action mailed July 27, 2004, which set a three-month shortened statutory period for response, to end October 27, 2004. This paper is timely filed within two months of the Final Office Action.

In the Action, the Office finally rejected claims 1-13, 15-17, and 31 under 35 U.S.C. § 103(a). The Office also objected to claims 7, 8, and 9, for formal reasons. In response to the Office Action, Applicant amends claims 7, 8, and 9 to address the Office's objections, leaving claims 1-13, 15-17, and 31 pending. The Office withdrew claims 22-30 from consideration for claiming non-elected subject matter.

### **Claim Objections**

The Office objected to claims 7, 8, and 9 for the recitation of "UV" where other claims had been amended to recite "ultraviolet." In response, and for consistency, Applicant amends claims 7, 8, and 9, and respectfully requests withdrawal of the objection.

### **Claim Rejections – 35 U.S.C. § 103**

The Office rejects claims 1-13, 15-17, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Chang et al. (U.S. Patent No. 5,141,744) in view of Bedding et al. (WO 94/19940) and Popiel et al. (U.S. Patent No. 5,183,950) for "those reasons set forth in the Office Action of September 29, 2003." (Office Action, page 4, lines 1-2.)

In response, Applicant reiterates the points made in the December 31, 2003 Response and adds the following. The maintained rejection is for obviousness, not anticipation. Obviousness requires that there be – in the absence of an applicant's disclosure – motivation to modify a prior art teaching or to combine prior art teachings.

The Office has identified three patent documents that allegedly disclose aspects of Applicant's claimed invention, picked only those portions of the documents that support the rejection, and then combined the teachings so as to arrive at the claimed invention. There is nothing in the art that suggests the combination of teachings as argued by the Office, and it can only be concluded that the Office has used Applicant's disclosure as a blueprint for the rejection. This sort of hindsight reasoning is improper and the Court of Appeals for the Federal Circuit has repeatedly warned against it.

In the outstanding Office Action, the Office states: "The art *combined herein clearly would have motivated* one of skill in the art to select the formulation and carry out a method of protecting plants from insects." (Office Action mailed July 27, 2004, page 5, lines 1-3, emphasis added.) To be clear, the Office is not saying that one of skill in the art would have been motivated to combine the art as suggested. Rather, it is saying that the motivation to perform the claimed invention comes *from* the already combined art. This clearly shows a misunderstanding of the requirements of an obviousness rejection.

Motivation is a requirement for the combination – there must be motivation to make the combination in the first place. *See*, M.P.E.P. 2143.01. Motivation is never evaluated after the art has been combined as suggested by the Office. Applicant respectfully submits that the Office's statement relating to motivation reveals its flawed reasoning: first finding isolated teachings in separate documents, combining the teachings, and then finding a reason for the combination. This is legally wrong.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). And

the motivation cannot be derived from an applicant's specification. Using an applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of prior art contravenes the statutory mandate of 35 U.S.C. § 103, which requires judging obviousness at the point in time when the invention was made. *See Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

Applicant respectfully submits that the Office has failed to establish a *prima facie* case of obviousness in this case and requests withdrawal of the rejections.

### **Conclusion**

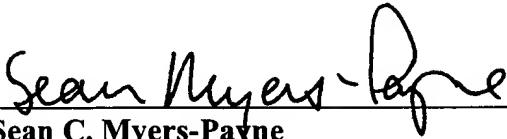
Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-13, 15-17, and 31 in condition for allowance. Applicant respectfully submits that the entering of the Amendment would allow Applicant to reply to the final rejections and place the application in condition for allowance. Also, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art documents cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 03-0172.

Respectfully submitted,

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**Sean C. Myers-Payne**  
Reg. No. 42,920  
(614) 621-7754  
(614) 621-0010 (fax)  
[smyers-payne@calfee.com](mailto:smyers-payne@calfee.com)